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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/027,417	12/20/2001	Lixiao Wang	1001.1461101	2784

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CROMPTON, SEAGER & TUFTE, LLC
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EXAMINER

GHAFOORIAN, ROZ

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 08/13/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

AK

Office Action Summary	Application No. 10/027,417	Applicant(s) WANG, LIXIAO	
	Examiner Roz Ghafoorian	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>6</u> . | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-4,7-8,11-14,16-17,22 rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO.5314386 to Trotta.

Trotta teaches a catheter shaft having an outer tubular member and an inner tubular member, wherein the inner tubular member has a proximal end, a distal end and a lumen extending therein, and further wherein the inner tubular member is coaxially disposed within at least a portion of the outer tubular, with a portion of the inner tubular member extending distally beyond the distal end of the outer tubular member; providing a polymeric insert; disposing the polymeric insert over a portion of the inner tubular member extending distally beyond the distal end of the outer tubular member; providing an expandable balloon 16 having a first end, a second end and an expandable region there between; affixing the first end of the expandable balloon to a portion of the outer tubular member; and affixing the second end of the expandable balloon to a portion of the polymeric insert. The discrete length of tie layer 28 is about the length as the proximal wait length.

When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although

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produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

2. Claims 1-4,7-8,11-14,16-17,22 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent NO.5769819 to Schwab et al.

Schwab teaches a catheter shaft having an outer tubular member 12 and an inner tubular member, wherein the inner tubular member has a proximal end, a distal end and a lumen extending therein, and further wherein the inner tubular member is coaxially disposed within at least a portion of the outer tubular, with a portion of the inner tubular member extending distally beyond the distal end the outer tubular member; providing a polymeric insert; disposing the polymeric inset over a portion of the inner tubular member extending distally beyond the distal end of the outer tubular member; providing an expandable balloon having a first end, a second end and an expandable region there between; affixing the first end of the expandable balloon to a portion of the outer tubular member; and affixing the second end of the expandable balloon to a portion of the polymeric insert . The discrete length of tie layer is about the length as the proximal wait length.

When the reference teaches a product that appears to be the same as, or an obvious variant of, the product set forth in a product-by-process claim although produced by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985).

Claim R jections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 5-6, 9, 10, 12-13, 15, 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No.5769816 to Schwab et al or US Patent NO.5312386 to Trotta as applied to claims 1, 4, 11 and 17 above, and further in view of US Patent No.6465067 to Wang et al.

As mentioned above, both Schwab and Trotta teache the invention however it does not teach the specific polymers used to manufacture the balloon or having multiple layer of the polymeric layer. Wang describes how balloons made from high or low PET are very well known in the art. (Col.1, lines 25-30)

In re Harza, 274 F.2d 669, 671, 124 USPQ 378, 380 (CCPA 1960) it would have been obvious to one having ordinary skill in the art to have duplicated the polymeric layer for multiple effect.

Therefore it would have been obvious to one having ordinarily skill in the art at the time the invention was made to have used high or low PET for Schwab or Trotta's balloons, because according to Wang PET are used often in balloon manufacturing due to there strength. (Col.1, lines25-30 and Col. 2, lines 35-40)

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4. Claims 1-4, 7-8, 11-14, 16-17, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,499,973 to Saab.

Saab teaches a catheter shaft 10 having an outer tubular member 12 and an inner tubular member 22, wherein the inner tubular member has a proximal end, a distal end and a lumen extending therein, and further wherein the inner tubular member is coaxially disposed within at least a portion of the outer tubular, with a portion of the inner tubular member extending distally beyond the distal end of the outer tubular member; providing a polymeric insert 30; disposing the polymeric insert over a portion of the inner tubular member extending distally beyond the distal end of the outer tubular member; providing an expandable balloon 16 having a first end, a second end and an expandable region there between; affixing the first end of the expandable balloon to a portion of the outer tubular member; and affixing the second end of the expandable balloon to a portion of the polymeric insert 30.

However Saad does not teach the discrete length of tie layer 28 is about the length as the proximal wait length.

At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to have shorten the length of the tie member because Applicant has not disclosed that shortening the length of the tie member provides an advantage, is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with a shorter tie length because they both perform the same function.

R sponse to Argum nts

5. Applicant's arguments with respect to claims 1-22 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roz Ghafoorian whose telephone number is 703-305-2336. The examiner can normally be reached on 8:30am-4:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 703-308-3552. Any inquiry of a general

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nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

RG

July 10, 2003


BRIAN L. CASLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700